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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,237	04/10/2006	Thomas Hickethier	2080.1025	6968
21171 7590 05/26/2009 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER				
CASCA, FRED A				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/575,237

Applicant(s)

HICKETHIER ET AL.

Examiner

FRED A. CASCA

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to applicant's amendment filed on February 25, 2009. Claims 9-18 are still pending in the present application. **This Action is made FINAL.**

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9-11, 14, 15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al (US 2003/0027570 A1) in view of Harada et al (US 5,572,524 A1) and further in view of Basilier et al (US 2003/0233457 A1).

Referring to claim 9, Yang discloses a method of backward-signaling of a transmission service used for setting up a call from a telecommunication network (abstract and Fig. 1), comprising

calling, from the telecommunication network (Fig. 1 and Par. 15 "PSTN"), a mobile terminal (Fig. 1 and Par. 15, line 12) in a service area of a destination mobile switching center (Fig. 1 and Par. 15) in a digital mobile radio network via an access mobile switching center (Fig. 1 and Par. 15, "serving MSC").

Yang further discloses information being stored in destination MSC (Par. 18, 20, 25, "serving MSC realizes that the first voice path includes links", note the MSC inherently does such realization based on the information stored in the MSC)

Yang does not specifically disclose negotiating transmission service to be used for the call, including at least a Bearer Capability (PLMN-BC) information element, wherein the destination mobile switching center converts the PLMN-BC information element into an Integrated Services Digital Network (ISDN) User Part (ISUP)-compliant (ISDN-BC) information element, and wherein the information is transported using at least one ISUP message at least to an access mobile switching center to effect the backward signaling.

Harada discloses a communication system that allows setting up a call between different networks and determining bearer capability (abstract, Figs. 1-4, col. 12, lines 55-67 and col. 13, lines 1-3, "when set-up message for setting up a call is received from ISDN ... determines whether the bearer capability BC contained in the SET-UP message").

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the method of Yang by incorporating the teachings of Harada and consequently providing negotiating, between the mobile terminal and the destination mobile switching center, information describing the transmission service to be used including the Bearer Capability, for the purpose providing an efficient communication system.

The combination of Yang/Harada does not specifically disclose converting the PLMN-BC information element into an Integrated Services Digital Network (ISDN) User Part (ISUP)-compliant (ISDN-BC) information element, and storing in the destination mobile switching

center and is transported using at least one ISUP message at least to an access mobile switching center to effect the backward signaling, in the format claimed.

Basilier discloses converting different messages (e.g., SIP messages) to ISDN User Part (ISUP), Par. 25, "converts SIP messages into a different format, such as ISDN User Part").

It would have been obvious to one of ordinary skill in the art the time of invention to modify the above combination such that the PLMN-BC information element is converted into an Integrated Services Digital Network (ISDN) User Part, and then transporting it using an ISUP message, as disclosed by Basilier, for the purpose of providing an efficient communication system.

Referring to claim 10, the combination of Yang/Harada/Basilier discloses the method according to claim 9, and further discloses the telecommunication network is an ISDN, a Public Switched Telephone Network (PSTN), or a Public Land Mobile Network (PLMN) (Yang, Fig. 1).

Referring to claim 11, the combination of Yang/Harada/Basilier discloses the method according to claim 9, wherein the information is transported using at least one ISDN User Part (ISUP) message (Basilier, Par. 25).

Referring to claim 14, the combination of Yang/Harada/Basilier discloses the method according to claim 9, and further discloses the information is evaluated in the access mobile switching center in order to execute transmission service specific functions contained therein (Yang, Par. 20-25).

Referring to claim 15, the combination of Yang/Harada/Basilier discloses comprising transmitting the information to at least one network node in the digital mobile radio network or in the telecommunication network to be involved in the call (Fig. 1 and Par. 13-18).

Claim 17 recites features analogous to the features of claim 9. Thus, the combination of Yang/Harada/Basilier discloses all elements of claim 17.

Claim 18 recites features analogous to the features of claim 9. Thus, the combination of Yang/Harada/Basilier discloses all elements of claim 18.

4. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al (US 2003/0027570 A1) in view of Harada et al (US 5,572,524 A1) and further in view of Basilier et al (US 2003/0233457 A1) and still further in view of Williams (2003/0099341 A1).

Referring to claim 12, the combination of Yang/Harada/Basilier discloses the method according to claim 11.

The above combination does not disclose wherein the at least one ISUP message is an Address Complete Message (ACM), an Answer Message (ANM), a Connect Message (CON), or a Call Progress Message (CPG).

Williams discloses that an ISUP message is an Address Complete Message (ACM), an Answer Message (ANM), a Connect Message (CON), or a Call Progress Message (CPG) (Par. 34).

It would have been obvious to one of the ordinary skill in the art the time of invention to modify the above combination in the format claimed for the purpose of providing an efficient communication system.

5. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al (US 2003/0027570 A1) in view of Harada et al (US 5,572,524 A1) and further in view of Basilier et al (US 2003/0233457 A1) and further in view of Hirani (US 2004/0198326 A1).

Referring to claim 13, the combination of Yang/Harada/Basilier discloses the method according to claim 11.

The combination is silent on the information being made available in an optional Access Transport parameter in the at least one ISUP message.

Hirani discloses information is made available in an optional Access Transport parameter in the at least one ISUP message (Par. 23).

It would have been obvious to one of the ordinary skill in the art the time of invention to modify the above combination in the format claimed for the purpose of providing an efficient communication system.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yang et al (US 2003/0027570 A1) in view of Harada et al (US 5,572,524 A1) and further in view of Basilier et al (US 2003/0233457 A1) and still further in view of Kauhanen et al (US 2004/0076145 A1).

Referring to claim 16, the combination of Yang/Harada/Basilier discloses the method according to claim 9.

The combination does not specifically disclose wherein the information comprises a Low Layer Compatibility information element (LLC) or a High Layer Compatibility information element (HLC).

Kauhanen discloses information comprising a Low Layer Compatibility information element (LLC) or a High Layer Compatibility information element (HLC) (Par. 32-37).

It would have been obvious to one of the ordinary skill in the art the time of invention to modify the above combination in the format claimed for the purpose of providing an efficient communication system.

Response to Arguments

7. Applicant's arguments with respect to rejection of claims 9-17 under 35 USC § 112 is persuasive, therefore the rejection of claims under 35 USC § 103 is withdrawn.

8. Applicant's arguments with respect to rejection of claims 9-17 under § 103 have been considered but are they are not persuasive.

9. In response to arguments that the application, describes that when a user is away from his home network, the user may wish to use services such as video, for which the respective destination network operator needs to provide far more resources than for normal telephony. For such services, the destination network will also incur higher charges. Before the invention, there was no way to easily account for the additional services provided to the user. Independent claim 9, the examiner asserts that that the features upon which the applicant relies are not cited in the

rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *See in re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).*

In response to arguments that Yang's describes a problem in that when a mobile unit roams, all call requests from a calling party to the called mobile unit are first routed through the home MSC of the called mobile unit. This happens even when the calling party is in close proximity to the called mobile unit and the home MSC is a far distance from the roaming/called mobile unit. To address this problem, Yang et al. proposes that a serving (local) MSC 150 initiate backward signaling to a switch 120 to set up a second voice channel that does not traverse the home MSC 140. See abstract. Specifically, the local MSC signals back to the switch of the calling party to initiate optimized routing. Backwards signaling is not described in any detail in the reference. However, backwards signaling results in a release of a first voice channel established with the home MSC, the examiner respectfully disagrees. Yang teaches backward-signaling of a transmission service used for setting up a call from a network to another network where network information is stored in the MSC. Harada teaches call setup procedures between different networks and determining bearer capability as part of the call set up in the setup message. And Basilier discloses converting SIP messages to ISDN User part (ISUP). Thus, all elements of the claimed invention are taught by the cited references, and a person of skilled in the art would be able to combine the references to conclude the claimed invention.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Yang teaches backward-signaling of a transmission service used for call set up in different network. Harada teaches call setup procedures between different networks and determining bearer capability as part of the call set up in the setup message. And Basilier discloses converting SIP messages to ISDN User part (ISUP). Thus, the references provide a piece of improvement to each other, and they all involve call set up between different network. Thus, a person of ordinary skill in the art would be able to combine the cited references so that the network would negotiate better call setup between different networks

In response to arguments that examiner is not allowed to engage in picking and choosing from prior art only to the extent that it will support a holding of obviousness, while excluding parts of the prior art essential to the full appreciation of what the prior art suggests to one of ordinary skill in the art, the examiner respectfully disagrees and asserts that the examiner has considered the entire references to the fullest and has cited the portions of the references relevant to the claimed invention. Further, all the used references are in a similar field of endeavor and they all discuss the subject matter of handover or call selection.

Conclusion

10. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred A. Casca whose telephone number is (571) 272-7918. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Harper, can be reached at (571) 272-7605. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/VINCENT P. HARPER/

Supervisory Patent Examiner, Art Unit 2617